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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,261	11/10/2000	John DeMayo	08011.3010-00000	6688
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3688	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/711,261

Applicant(s)

DEMAYO ET AL.

Examiner

Donald L. Champagne

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Period for Reply
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 8, 9, 12, 14-21, 23, 24 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 8, 9, 12, 14-21, 23, 24 and 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-552) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 5, 9, 12, 14, 15, 17, 18, 21, 24, 27, 28, 31, 33 and 34 are rejected under 35 U.S.C. 102(e) as being unpatentable over Bull et al. (US005995943A) in view of Rodkin et al. (US006092074A).
3. Bull et al. teaches (independent claims 1, 9, 17, 21, 24, 27, 31, 33 and 34) an apparatus and method for hyperlinking specific words in content or in text-containing files, or displayed in an application, to convert the words into advertisements, the method (as expressed by claim 9) comprising:

connecting a content provider server to the Internet, said content provider having content files to be displayed (col. 3 lines 31-34 and 66-67);

providing an advertiser web page so as to be accessible over the Internet (the *Advertising DataStore 250*, col. 12 lines 32-34 and Fig. 2); and

connecting an ad server (*advertiser's computer system 400*, col. 8 line 10 and Fig. 1) to the Internet, wherein the ad server provides hot links (col. 8 line 19-21), which reads on hypertext links or hyperlinks (Microsoft Press Computer Dictionary), to convert at least one existing word (e.g., Holiday Inns on the West Coast, col. 15 lines 39-42) present in a content file into one or more advertisements (e.g., an ad for Hilton Inns on the West Coast) by linking an Internet-enabled web browsing device (network addressable interface device, col. 3 lines 28-29) connected to the Internet to said advertiser web page (col. 15 lines 30-33). Bull et al also teaches the hypertext link at col. 3 lines 51-59. Bull et al. also

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teaches (claims 1 and 21) a terminal (*user access system 100*) for connection to the Internet¹.

4. Bull et al. also teaches that said word or phrase is advertiser-chosen. The reference teaches that the advertiser chooses the criteria by which the ads are placed (col. 8 lines 3-5 and 19-22), said advertiser-chosen criteria being used to choose said word(s) (col. 15 lines 24-29).
5. Bull et al. does not teach referencing, by code in one of said content files, said ad server to determine at least one existing advertiser-chosen word present in said content file. Rodkin et al. teaches referencing, by code in one of said content files (*hypertext links*, col. 22 lines 7-8), said ad server (the *central server*, col. 22 lines 21-23 and col. 24 lines 1-3) to determine at least one existing advertiser-chosen word present in said content file (col. 22 lines 13-16, where establishing the fresh destination address of said *hyperlinks* reads on "determine at least one existing advertiser-chosen word present in said content file"). Because Rodkin et al. teaches that this corrects an out-of-date destination address (col. 22 lines 21-23), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Rodkin et al. to those of Bull et al.
6. In addition, under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Bull et al. teaches converting an advertiser-chosen word into an ad at another site. Rodkin et al. teaches assuring that the address of that ad site is up to date.
7. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, no patentable weight was given to the following claim language²:

"said code automatically, when said content file is interpreted by a web browser, providing a hypertext anchor for said at least one existing advertiser-chosen word, thereby

¹ Claim 21, 7th line from the end, has a typo, "filem", which is interpreted to mean – file, --.

² The claim language implies an alternative limitation, "when said content file is not interpreted by a web browser". When alternative limitations are claimed, prior art that reads on any of the alternatives reads on the claim.

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converting said at least one existing advertiser-chosen word into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page."

8. However, to expedite prosecution, the examiner notes further that Rodkin et al. does teach the optional limitation at col. 15, lines 8-17 and 36-42.
9. Rodkin also teaches claims 17 and 27 (col. 24 lines 1-3).
10. Bull et al. does not explicitly teach (independent claim 31) displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, the reference teaches clicking on a URL (col. 14 lines 50-52), in order to access a Web page. The mouse pointer must inherently be positioned over the URL link in order to activate said link by clicking on it.
11. Bull et al. also teaches at the citations given above claims 4, 5 and 12.
12. Bull et al. does not teach (claims 14 and 15) using frames to display the content provider URL in a browser window. It was common, at the time of the instant invention, to use script to provide a hypertext anchor and display the URL of content in a browser window using frames. Because it is efficient to use common and well known practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Bull et al. the use of script to provide a hypertext anchor and the use of frames to display the content provider URL in a browser window.
13. Official notice of this common knowledge or well known in the art statement was taken in the Office action mailed 2 August 2004 (para. 11). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.).
14. Claims 18 and 28 add only non-functional descriptive material and were not given patentable weight (MPEP § 2106.01). In the sense used in the patent law (35 USC 101), a payee is not functional because it is neither "tied to a particular apparatus" nor "operates to change materials to 'a different state or thing'" (*IN RE COMISKEY*, CAFC 2006-1286, September 2007). Furthermore, it is noted that it is obvious to pay anyone

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when it serves the interests of a business. Paying at least one of a content provider and an entity that selects said hypertext anchor would obviously make them more willing to accept advertising.

15. Claims 8, 16, 19, 20, 23, 26, 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bull et al. in view of Rodkin et al. and further in view of Kirsch et al. (US006189030B1).
16. Neither Bull et al. nor Rodkin et al. teach linking to said advertiser web page using a tracking URL (claims 8, 16, 20, 23, 26 and 30). Kirsch et al. teaches linking to said advertiser web page (*the external server* system, col. 7 lines 10-17) using a tracking server system (col. 5 lines 14-26), which reads on a tracking URL. Because Kirsch et al. teaches that tracking clicks is important (col. 2 lines 34-38 and col. 6 lines 60-61) and that the reference invention does so expediently, with minimum latency and visibility (col. 5 lines 33-37), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Kirsch et al. to the teachings of Bull et al. and Rodkin et al.
17. Kirsch et al. also teaches that the limitations of claims 19, 29 and 32 are common (col. 2 lines 29-38).

Response to Arguments

18. Applicant's arguments filed with an amendment on 5 June 2008 have been fully considered but they are not persuasive. With the following exception, the arguments have been addressed by the revised rejection.
19. Applicant argues (p. 16, middle), regarding the rejection of claim 31 as inherent (para. 10 above and para. 9 of the Office action mailed on 26 February 2008),

"However, positioning a mouse pointer over a URL link in order to click on the link does not constitute 'displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink,' as recited in claim 31." (End of the first full para. on p. 16 of the 5 June 2008 filing)

The mouse must be positioned over the URL link in order to click on it, and clicking on it necessarily produces the advertiser web page, said web page itself reading on "a description of the advertiser web page".

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
23. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722.
24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
25. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be

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accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words.

Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

26. Applicant may have after final arguments considered and amendments entered by filing an RCE.
27. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).
28. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

25 October 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688